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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2452

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/614,867	Applicant(s) SAHAI ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response to Applicant's request for continued examination. Claims 1-9 and 17 are amended. Claims 1-18 are presented for further examination.
2. This action is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/8/2008 has been entered.

Response to Arguments

4. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 17 is directed to a system comprising entirely of software

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modules. Therefore, claim 17 is directed to a purely software invention which does not fall under any of the statutory categories established under §101. Claim 9 is rejected for similar reasons. To overcome this rejection, Applicant should amend the claims with limitations that would require interpreting the claimed system as a machine (such as including hardware limitations).

Claim Interpretation

6. The examiner recommends amending limitations of the independent claims in a manner that they affect the claims' scope. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. *See MPEP §2111.04*. For example, a whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited. *Id.*

Here, claim 1 contains two whereby clauses that are merely the intended result of preceding process steps and therefore does not affect the claim's scope and is not given any patentable weight. Specifically, claim 1 recites “whereby the user who already possesses said product or service will not receive duplicate offers to supply said product or service from multiple Web sites” and “whereby the user who already possesses said product or service is not shown any updated offers of the product or service.”

These whereby clauses simply expresses the intended result of the preceding storing and redirecting steps. These limitations should be rewritten such that the functionality contained in the language are actual process steps that are required to be performed. For example, Applicant

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may consider adding language to the effect of "if the user receives an offer for said product or service from a third web site, not displaying the offer if user already possessed said product or service."

For apparatus claims, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *MPEP §2114* (citing *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997)). The whereby clauses of claim 9 fail to limit the claim to a particular structure and instead relies on functional language to describe the particular claimed system. Therefore, the language in the whereby clauses is not given any patentable weight. Applicant should rewrite the limitations such that the limitations affect the claimed system in terms of its structural features.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. There is an antecedent problem in claims 1 and 9. There are two different "products" or "services" being claimed, one from a first website and one from a second website. Thus, the references to "said" product or service is confusing because it is unclear to which product or service the terms are intended to refer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 9-14, 17, and 18 are rejected under 35 U.S.C. §102(e) as being anticipated by Callaghan et al, U.S. Patent No. 7.302.402 [“Callaghan”].

9. As to claims 1, 9, and 17, Callaghan discloses a method for redirecting a user from a second Web site to a first Web site, comprising the steps of:

(1) acquiring, by the user, a product or service from the first web site, the acquisition of the product or service being made in response to an offer for the product or service by the first web site [Fig. 8 «item 806»: offering IBM Aptiva computer];

(2) placing, by the first website, a cookie on a computer of the user [Fig. 8 «item 808»];

(3) providing, by the second Web site, a URL offering a product or service to the user, said URL specifying a program on the second Web site [Fig. 8c «item 854»: lotus.com (second website) offering lotus notes to the user];

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(4) reading, by said program, a cookie located in the user's computer in response to the user activating said URL [Fig. 8a «item 820»: storing "Aptiva" cookie on user's computer | column 12 «lines 12-22»];

(5) providing a positive determination when an inquiry by said program, from said cookie as to whether the user already possesses said product or service is true [column 12 «lines 40-44»];

(6) redirecting, by said program, the user to the first Web site when the determination of step (5) is positive determination, wherein the first Web site is specified by said cookie [column 12 «lines 23-31»]; and

(7) offering, by the second Web site, to supply said product or service to the user when the determination of step (5) is negative [column 12 «lines 40-44»];

whereby the user who already possesses said product or service will not receive duplicate offers to supply said product or service from multiple Web sites;

whereby the user who already possesses said product or service is not shown any updated offers of the product or service.

10. As to claims 2, 10, and 18, Callaghan discloses the method of claim 1, wherein said providing of step (1) comprises at least one of the following steps of: sending an e-mail including a link to said URL to the user; providing a Web page including a link to said URL to the user [column 11 «lines 45-48»]; and providing a computer program including a link to said URL to the user.

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11. As to claims 3 and 11, Callaghan discloses the method of claim 2, wherein said activating of step (2) comprises at least one of the steps of: clicking a link to said URL on a Web page [column 11 «lines 45-48»]; clicking a link to said URL in an e-mail; and executing a computer program that activates a link to said URL.

12. As to claims 4 and 12, Callaghan discloses the method of claim 1, further comprising a step of: placing, by the first Web site, said cookie the user's computer in response to the user registering with the first Web site for said product or service, said cookie including the URL of the first Web site [Fig. 7a «items 714, 718: user logging in results in cookie from ibm.com»].

13. As to claims 5 and 13, Callaghan discloses the method of claim 1, wherein said program is a server side program [Fig. 8a «item 804»].

14. As to claims 6 and 14, Callaghan discloses the method of claim 5, wherein said program is at least one of the following: a CGI script [column 1 «lines 33-36»]; a Java servlet; a PHP script; and a Perl script.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callaghan in view of applicant's admitted prior art.

16. As to claim 7, 8, 15, and 16, Callaghan does not disclose wherein said program is a client side program that is downloaded from the second Web site wherein the program is at least a Java applet or an ActiveX control. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Applicant's admitted prior art. Applicant states "ActiveX controls and Java applets used to access the file system were well-known to those reasonably skilled in the art at the time of the present invention." See page 34, lines 1-7 of the appeal brief filed 6/3/2005. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Callaghan by adding the ability for the program to be a client side program such as ActiveX controls or a java applet that is downloaded from the second Web site as provided by APA.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kirsch, U.S. Patent No. 5,963,915.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452